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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,119	05/01/2006	Robert Chassagnon	5460-69/PUS	5029
27799 7590 03/16/2010 COHEN, PONTANI, LIEBERMAN & PAVANE LLP 551 FIFTH AVENUE SUITE 1210 NEW YORK, NY 10176				
EXAMINER				
SCOTT, ANGELA C				
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1796				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/578,119

Applicant(s)

CHASSAGNON ET AL.

Examiner

Angela C. Scott

Art Unit

1796

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 19-21 is/are rejected.
- 7) ☒ Claim(s) 19-21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's response of December 12, 2009 has been fully considered. Claims 19-21 have been added and claims 1-14 and 19-21 are pending.

Claim Objections

Claims 19-21 are objected to because of the following informalities: In claims 19 and 20, the abbreviation "SBR" should be spelled out as styrene butadiene rubber. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hopkins (US 2002/0198305) in view of Vasseur et al. (WO 02/088238). For convenience, the citations below for Vasseur et al. are from English language equivalent (US 2004/0127617).

Hopkins teaches vehicle tires with treads made from a rubber composition (¶84) comprising a mixture of natural rubber and brominated butyl rubber (¶3, 13), silica (¶20), and a coupling agent (¶8). The butyl rubber may be present in from 30 to 75 phr with the natural rubber making up the remainder of the elastomer component in an amount to give 100 phr of the elastomer component (Table 1, examples 4-6) and the silica is present most preferably in 40 to 80 phr (¶78).

Hopkins et al. does not teach that the composition contains from 15 to 30 phr of glycerol trioleate, which has an oleic acid content of more than 80% by weight, or sunflower oil having an oleic acid content of more than 80% by weight. However, Vasseur et al. teaches a rubber composition for a tire tread that contains from 10 to 40 phr of a plasticizer that is glycerol trioleate (having an oleic acid mass fraction equal to or greater than 85%) or a high oleic acid sunflower oil (having an oleic acid mass fraction equal to or greater than 85%) (¶64-71). Hopkins and Vasseur et al. are analogous art because they are from the same field of endeavor, namely that of rubber compositions for tire treads. At the time of the invention, a person of

ordinary skill in the art would have found it obvious to use a plasticizer, as taught by Vasseur et al., in the composition, as taught by Hopkins, and would have been motivated to do so because Vasseur et al. suggests the grip performance of the tire tread is conserved over time when this type of plasticizing agent is used in the rubber composition of the tire tread (§40).

Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hopkins (US 2002/0198305) in view of Vasseur et al. (WO 02/088238) as applied to claim 1 above, and further in view of Simonot et al. (US 2004/0030017).

Hopkins and Vasseur et al. teach the tire and composition of claim 1. Hopkins does not teach that the diene elastomer component of the composition further comprises a styrene butadiene rubber prepared in a solution and a polybutadiene rubber. However, Simonot et al. teaches rubber composition for tire treads (Abstract) that contain diene rubbers. Simonot et al. lists many examples of diene rubbers as satisfactory choices, such as natural rubber (§80), for the composition. Moreover, for a passenger car, Simonot et al. teaches that the diene rubber is preferably a styrene butadiene rubber (solution prepared)/butadiene rubber blend (§82). Hopkins and Simonot et al. are analogous art because they are from the same field of endeavor, namely that of diene rubber compositions for tire treads. At the time of the invention, a person of ordinary skill in the art would have found it obvious to substitute the styrene butadiene rubber/butadiene rubber blend, as taught by Simonot et al., for the natural rubber component of Hopkins, and would have been motivated to do so because the prior art recognizes them as being equivalents known for the same purpose and, moreover, the blend of Simonot et al. is more preferable for passenger car tires, which the instant claim desires.

The Office would like to note that the limitation of claim 20 regarding the solution polymerization of styrene butadiene rubber is a product-by-process limitation. It has been taught by Simonot et al. However, for future reference, even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Response to Arguments

Applicant's arguments filed December 11, 2009 have been fully considered but they are not persuasive.

Applicants argue that Hopkins does not teach that its composition is used for passenger car tires. However, Hopkins teaches that its composition is used in tire tread compositions for vehicles. A passenger car is a type of vehicle. While Hopkins goes on to say that it is especially useful for tire tread of trucks and buses, it does not exclude other types of vehicles. Moreover, in paragraph 2 of Hopkins, desirable properties of a vehicle tire, such as good wet traction, good wear characteristics, and low rolling resistance, are listed and it is noted that these are desirable properties for all vehicle tires, not just tires for trucks and buses. Therefore, this argument is unpersuasive as Hopkins teaches utility for all vehicle tire treads.

Applicants argue that there is no apparent motivation for a person of ordinary skill in the art to add the triesters of Vasseur into the composition of Hopkins because Vasseur is directed tires for a light passenger vehicle running at high speed and Hopkins is directed to a heavy vehicle running at a low speed. This argument is also unpersuasive. As discussed above, the composition taught in Hopkins finds utility in tire treads for all vehicles. It is not limited to those for "a heavy vehicle running at a low speed." The motivation listed above for combining the references in this manner, conserving grip performance, would be desirable for almost any type of tire and certainly tires for tires used to run typical vehicles on typical roads such as passenger cars, trucks, and buses.

Applicants argue that there would be no reasonable expectation of success for a modification of Hopkins with Vasseur. In making this assertion, applicants point to the fact that the composition of Hopkins differs from that of Vasseur. While the compositions between the two references are not the same, they both have similar utility (tire treads) and both contain diene rubbers (natural rubber and styrene butadiene rubbers, for example) as a component of their composition. One would not expect that the compositions would have to be exactly the same in order to expect success with a modification, especially when that modification deals with an additive to the composition.

Lastly, applicants argue that they have shown unexpected results. To that end, applicants point to examples C-1 and C-2 in their specification. This argument is unpersuasive. Only two examples are shown, one inventive and one comparative, and these examples do not give a good side by side comparison, i.e., more than one variable is changed between the two compositions and it is not clear from what change in the composition the change in results stems. Additionally, broader ranges are claimed for each of the components in the claims than what is shown in the experiments. Therefore, these results are not commensurate in scope with the claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angela C. Scott whose telephone number is (571) 270-3303. The examiner can normally be reached on Monday through Friday, 8:30am to 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on (571) 272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Eashoo/
Supervisory Patent Examiner, Art Unit 1796

/A. C. S./
Examiner, Art Unit 1796
March 11, 2010